

REMARKS

In the final Office Action mailed on April 18, 2007, the Examiner rejected claims 164-167 under 35 U.S.C. § 112 as being indefinite; rejected claims 1, 2, 4, 7, 120, 121, 124, 126, 127, 129, 130, 134, 135, 137, 138, 140, 142, 143, 147-153, 157, and 164-167 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,849,019 ("Yoon"); and rejected claims 5, 131, 132, 144, 145, 154, and 155 under 35 U.S.C. § 103(a) as being unpatentable over Yoon in view of U.S. Patent No. 3,032,039 ("Beaty").

By this amendment, Applicant amends claims 1, 120, 135, 148, and 164-167 and adds new claims 172-179. Claims 1, 2, 4, 5, 7, 120, 121, 124, 126, 127, 129-132, 134, 135, 137, 138, 140, 142-145, 147-155, 157, 164-167, and 172-179 are currently pending. Of these, claims 1, 120, 135, and 148 are independent.

With regard to the Examiner's rejection of claims 164-167 under 35 U.S.C. § 112 as being indefinite, although Applicant does not necessarily agree with the Examiner's assertions, Applicant has amended claims 164-167 to advance prosecution of this case. Specifically, Applicant has changed the claims to recite a device (e.g. a clip) that "does not require removal." Support for these claim amendments can be found, for example, in paragraph 76 of the application. Applicant therefore requests that the rejection of dependent claims 164-167 under 35 U.S.C. § 112 be reconsidered and withdrawn.

The Examiner next rejected claims 1, 2, 4, 7, 120, 121, 124, 126, 127, 129, 130, 134, 135, 137, 138, 140, 142, 143, 147-153, 157, and 164-167 under 35 U.S.C. § 102(b) as being anticipated by Yoon. Amended independent claim 1 recites, among other things, a device that comprises first and second arms, each with a first and second end, "wherein the second end of the first arm is configured to maintain a non-

contacting relationship with the second end of the second arm when the device is in an initial, normal position.” Independent claims 120, 135, and 148 include similar recitations.

The Examiner contends that, in Yoon, outer leg segments 124 and 126 of the clip correspond to the claimed first and second arms and that connecting segments 132 and 134 correspond to the claimed second ends of the first and second arms. Even assuming that connecting segments 132 and 134 can be interpreted to correspond to the claimed second ends of the arms, which Applicant does not concede, Yoon does not disclose or suggest arms whose second ends “maintain a non-contacting relationship . . . when the device is in an initial, normal position.” In fact, Yoon teaches away from such a relationship because “clip 110 is normally disposed in the closed position with legs 114 and 116 biased inwardly to position grasping surfaces 118 and 120 in contact with one another as shown in Fig. 9.” Yoon, col. 8, ll. 42-45.

With regard to the Examiner’s rejection of claims 5, 131, 132, 144, 145, 154, and 155 under 35 U.S.C. § 103(a) over Yoon in view Beaty, these claims all depend from one of independent claims 1, 120, 135, and 148 and are allowable for at least the reasons outlined above. Additionally, Beaty does not overcome the above deficiency in the teachings of Yoon, as Beaty describes clamps with arms that “are pressing against each other as at 10 with a substantial clamping force.” Beaty, col. 2, ll. 10-11.

Accordingly, neither Yoon nor Beaty, alone or in combination, teaches each and every element of independent claims 1, 120, 135, and 148. Therefore, independent claims 1, 120, 135, and 148 and their dependents are allowable over these references.

Applicants have also added new dependent claims 172-179. In addition to being allowable for the reasons recited above, new dependent claims 172, 174, 176, and 178 each recite an anchoring portion (or projection) that “includes at least a portion in the shape of a barb configured to penetrate the surface of the fold of tissue.” Neither Yoon nor Beaty teaches such an anchoring portion. For example, Yoon teaches away from such an anchoring portion because it states that “[w]here clips are made of bioabsorbable materials, it is desirable that the clips have no sharp edges, corners, or small dimensioned pieces which would present areas for ready absorption.” Yoon, col. 11, ll. 11-14. Thus, Yoon does not suggest an anchoring portion that “includes at least a portion in the shape of a barb configured to penetrate the surface of a fold of tissue.” Similarly, Beaty does not disclose or suggest such an anchoring portion, as the clamps in Beaty comprise smooth strips of metal. See Beaty, Figs. 1-3; col. 2, ll. 6-9. Accordingly, neither Yoon nor Beaty, alone or in combination, teaches each and every element of dependent claims 172, 174, 176, and 178. Therefore, dependent claims 172, 174, 176, and 178 are allowable over these references.

In addition to being allowable for their dependency from independent claims 1, 120, 135, and 148, new dependent claims 173, 175, 177, and 179 each recite a second (or distal) end of first and second arms that “has a crook for providing a surface to push against to bring the arms closer together during insertion.” Neither Yoon nor Beaty teaches such a crook. For example, Yoon, as described above, teaches that “[w]here clips are made of bioabsorbable materials, it is desirable that the clips have no sharp edges, corners, or small dimensioned pieces which would present areas for ready absorption.” Yoon, col. 11, ll. 11-14. Thus, Yoon teaches away from such a crook and

would not be modified to include such a crook. Accordingly, dependent claims 173, 175, 177, and 179 are allowable.

For the above reasons, Applicant respectfully requests that the Examiner withdraw rejections of all pending claims and allow this application.

The Office Action contains characterizations of the claims and related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and/or drawings in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to an exemplary embodiment described in the specification or abstract and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1, 2, 4, 5, 7, 120, 121, 124, 126, 127, 129-132, 134, 135, 137, 138, 140, 142-145, 147-155, 157, 164-167, and 172-179 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 120, 135, 148, and 164-167 and the addition of claims 172-179 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment

would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

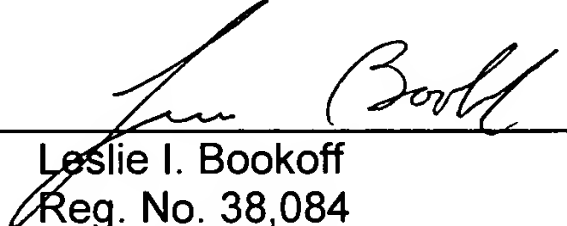
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: July 18, 2007

By: _____


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